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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/706,065

11/12/2003

Michael Sittinger

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07/14/2008

MCCRACKEN & FRANK LLP

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EXAMINER

NICHOLSON III, LESLIE AUGUST

ART UNIT

PAPER NUMBER

3651

MAIL DATE

DELIVERY MODE

07/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/706,065

Applicant(s)

SITTINGER ET AL.

Examiner

LESLIE NICHOLSON III

Art Unit

3651

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 56-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/16/2008 has been entered.

Election/Restrictions

2. Newly submitted claims 56-68 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Claims 56-61 disclose the times required to print the first and second signatures being substantially different, which is not disclosed by the originally claimed invention.

Claims 62-68 disclose a first and second demand printer for printing and supply first and second signatures, respectively, to the feeding device, which is not disclosed by the originally claimed invention.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 56-68 are hereby withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

3. Applicant's arguments filed 6/16/2008 have been fully considered but they are not persuasive.

Applicant argues Weller is silent regarding a controller. In response, Weller inherently discloses a controller as discussed in at least ¶¶1,2 of the Action filed 2/12/2008.

Applicant argues none of the prior art cited by the examiner, either alone or in combination, teaches or suggests a controller that controls the operation of a gathering line, feeding device, and a demand printer as recited by claims 1-35,43-48, and 55, or a step of coordinating simultaneous operation of a gathering line, a demand printer, and a feeding device during a production sequence to produce books as recited by claims 36-42 and 49-54. In response, the Examiner disagrees. Warmus ('599) teaches the use of a demand printer as shown below in the field of book production apparatuses in at least figure 2 and discloses conventional printers in a finishing line including a gathering line and a feeding device in C1/L33-45 and the advantage of using demand printers in C2/L41-C3/L5. Warmus discloses the use of replacing conventional printers in book production apparatuses with demand printers in his Background Art (C1/L11-C3/L5). Therefore, the use of a controller that controls the operation of a gathering line, feeding device, and a demand printer as recited by claims 1-35,43-48, and 55 and a step of

coordinating simultaneous operation of a gathering line, a demand printer, and a feeding device during a production sequence to produce books is obvious through the combinations shown in the Action filed 2/12/2008 and below.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1,2,8,9,13,23,24,30,31,35,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599.

Dooley discloses a book production device that includes a gathering line (14); a printer (56); a feeding device (58); a packer box (16) with a transfer mechanism (C4/L3); and a controller (60). Dooley does not expressly disclose the printer being that of a demand printer or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches a demand printer (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the

production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printer to be that of a demand printer, as taught by Warmus, in the device of Dooley, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

6. Claims 1,2,12-16,20,22-24,35-38,43-45,49-51,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599.

Graushar discloses a book production device that includes a gathering line (18); a plurality of printers (32, C4/L51); a feeding device (33); and a controller (31). Graushar does not expressly disclose the printers being that of demand printers or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches demand printers (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page (at

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least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printer to be that of demand printers, as taught by Warmus, in the device (or method) of Graushar, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

7. Claims 1,2,6,7,12-18,20,22-24,28,29,35-38,41,43-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weller USP 4,989,850 in view of Warmus USP 6,327,599.

Weller discloses a book production apparatus that includes a gathering line (90); a plurality of printers (75, C5/L1-6); a feeding device (GR); a folding device (C4/L56); and a controller (C3/L56). Weller does not expressly disclose the plurality of printers being that of demand printers or means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page.

Warmus teaches demand printers (C6/L25) and means for printing the customized content on at least a portion of each page without limitation as to the

orientation and position of the customized content over an entire surface of the page (at least C7/L36-49, fig.6-8) for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run (C4/L4-8).

At the time of invention it would have been obvious to one having ordinary skill in the art to employ means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page and modify the printers to be that of demand printers, as taught by Warmus, in the device (or method) of Weller, for the purpose of permitting high speed printing to the production of differing books with customized and/or personalized information within a single production run.

8. Claims 3-5,25-27,39,40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Graushar USP 5,100,116 in view of Warmus USP 6,327,599 further in view of Warmus USP 5,963,968.

Graushar discloses all the limitations of the claims, but it does not disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file.

However, Warmus ('968) discloses a book production device that includes disclose utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a

database and a press command file for the purpose of producing differing book versions in an efficient manner (C3/L8-10).

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Graushar by utilizing a template file having fixed and variable information separated into data streams and provided to a collator/raster image processor together with a database and a press command file, as disclosed by Warmus ('968), for the purpose of producing differing book versions in an efficient manner.

9. Claims 10,11,14,17,19,32-34 rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Weller USP 4,989,850.

Dooley discloses all the limitations of the claims, but it does not disclose a folder and it does not disclose a plurality of demand printers.

However, Weller discloses a book production device that includes a folder for the purpose of processing signatures which have not been folded (C3/L4-6) and Weller discloses utilizing a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a folder and a plurality of demand printers, as disclosed by Weller, for the purpose of processing signatures which have not been folded and customizing more than one page.

10. Claims 14,21,36,42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dooley USP 6,257,566 in view of Warmus USP 6,327,599 further in view of Graushar USP 5,100,116.

Dooley discloses all the limitations of the claims, but it does not disclose a plurality of demand printers.

However, Graushar discloses a book production device that includes a plurality of demand printers for the purpose of customizing more than one page.

It would have been obvious for a person of ordinary skill in the art at the time of the applicant's invention to modify Dooley by utilizing a plurality of demand printers, as disclosed by Graushar, for the purpose of customizing more than one page.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LESLIE NICHOLSON III whose telephone number is (571)272-5487. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on 5712726911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gene Crawford/
Supervisory Patent Examiner, Art
Unit 3651

/L. N./
Examiner, Art Unit 3651
7/8/2008